



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,672	06/26/2003	David A. Steinberg	020748.0122D1US	5349

7590 02/07/2007
IP Department
Patton Boggs, LLP
Suite 3000
2001 Ross Avenue
Dallas, TX 75201

EXAMINER

MOORE JR, MICHAEL J

ART UNIT	PAPER NUMBER
----------	--------------

2616

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/606,672

Applicant(s)

STEINBERG, DAVID A.

Examiner

Michael J. Moore, Jr.

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 15-24, 26-32, 34 and 35 is/are rejected.
- 7) ☒ Claim(s) 14, 25 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 8/30/04 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

Drawings

2. The drawings are objected to because of the following informalities:
In Figure 2, in the text located next to the "Intelligent Information Interconnect", the word "wireless" is spelled wrong in the second line.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the

Art Unit: 2616

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: On page 1, line 2, the word "of" is needed after the word "capable". Also, on page 1, line 7, the word "gown" should be "grown". Appropriate correction is required.

Claim Objections

4. Claims 13, 15, 18, 20, 25, 26, and 34 are objected to because of the following informalities:

Regarding claim 13, on line 4, the word "on" should be "in".

Regarding claim 15, there is some confusion regarding the language "receiving a user's preference relating to an order of said wireless devices said messages are to be sent when said user has a plurality of said wireless devices". It is unclear what this limitation is referring to.

Regarding claim 18, there is some confusion regarding the language "providing access to step of only a predetermined subset of said database to a given user". It is unclear what this limitation is referring to.

Regarding claim 20, on line 2, the word "on" should be "in". Also, on lines 6-7, there is some confusion regarding the language "in response to a request from one of a user interface and subscription information contained in said content subscription lists". It is understood how a request can be received from a user interface, but it is unclear how a request can be received from subscription information.

Regarding claim **25**, on line 1, the word "he" should be "The". Also, on line 1, the word "locking" should be "looking". Also, on line 2, the word "locking" should be "looking".

Regarding claim **26**, there is some confusion regarding the language "receiving a user's preference relating to an order of said wireless devices said messages are to be sent when said user has a plurality of said wireless devices". It is unclear what this limitation is referring to.

Regarding claim **34**, there is some confusion regarding the language "receiving a user's preference relating to an order of said wireless devices said messages are to be sent when said user has a plurality of said wireless devices". It is unclear what this limitation is referring to.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims **13, 15-24, 26-32, 34, and 35** are rejected under 35 U.S.C. 102(e) as being anticipated by Fortman et al. (U.S. 5,987,100) (hereinafter "Fortman"). *Fortman* teaches all of the limitations of the specified claims with the reasoning that follows.

Regarding claim 13, "receiving identifying information regarding at least one wireless device; storing the identifying information in a database; receiving and storing delivery preference hierarchy information for delivering content to the wireless device(s)" is anticipated by subscriber mailbox 330 of Figure 3 that stores a database of subscriber profile data (identifying information, delivery preference hierarchy information) including subscriber-defined information regarding the subscriber's notification preferences as spoken of on column 5, lines 42-54.

"Receiving a voice message, an email message or a fax message at a single access point of the network, the message having content in a first format and indicating specifying criteria directed to at least one selected wireless device" and "searching the database using the specifying criteria to determine at least one selected device ID" is anticipated by subscriber mailbox 330 of Figure 3 that receives a message from a caller in the caller format (first format) as well as service provider 320 that detects caller information (specifying criteria) and notifies the subscriber of the pending message according to the subscriber profile data (device ID) stored in the subscriber mailbox 330 (database) as spoken of on column 7, lines 5-16.

"Translating the first format of the content to a second format compatible with the selected wireless device(s) including performing one or more operations on the content selected from the group of clipping, transcoding, and decoding" is anticipated by message translator 340 of Figure 3 that determines the subscriber's normal retrieval format (second format) from the subscriber profile data and then translates

(transcoding) the message from the caller format (first format) to the subscriber's normal retrieval format (second format) as spoken of on column 7, lines 20-31.

Lastly, "transmitting the content in the second format to the selected wireless device(s) corresponding to the selected device ID using the delivery preference hierarchy information" is anticipated by the sending of the message to the subscriber (selected device ID) based on the detected type of subscriber equipment and any subscriber specified retrieval format in comparison to the subscriber profile data (delivery preference hierarchy information) as spoken of on column 7, lines 41-64.

Regarding claim 15, "wherein receiving the delivery hierarchy preference information includes receiving a user's preference relating to an order of the wireless devices the messages are to be sent when the user has a plurality of the wireless devices" is anticipated by subscriber mailbox 330 of Figure 3 that stores a database of subscriber profile data (identifying information, delivery preference hierarchy information) including subscriber-defined information regarding the subscriber's notification preferences as spoken of on column 5, lines 42-54.

Regarding claim 16, "wherein the user's wireless devices provide a variety of content formats, and the order of the wireless devices is established by the user selecting an order of content formats" is anticipated by the subscriber specifying a retrieval format of a message such as voice or text form (content formats) as spoken of on column 7, lines 45-52.

Regarding claim 17, "entering at least one of the identifying information and the delivery preference hierarchy information on a user interface providing a web page

accessible via a communication network” is anticipated by a subscriber that submits a request for retrieval via interface 310 (user interface) of Figure 3.

Regarding claim 18, “providing access to step of only a predetermined subset of the database to a given user; and searching the predetermined subset to select the device ID” is anticipated by service provider 320 that detects caller information and notifies the subscriber of the pending message according to the subscriber profile data (device ID) stored in the subscriber mailbox 330 (database) as spoken of on column 7, lines 5-16:

Regarding claim 19, “entering at least one of the identifying information and the delivery preference hierarchy information on a user interface providing a menu structure compatible with a touch tone phone” is anticipated by a subscriber that submits a request for retrieval via interface 310 (user interface) of Figure 3.

Regarding claim 20, “storing the content as content on a content database” and “managing content data stored in the content database and managing content subscription lists for each of the wireless devices with a content management system” is anticipated by subscriber mailbox 330 (database) of Figure 3 that stores subscriber messages in different subscriber formats as spoken of on column 5, lines 34-35.

Lastly, “selectively providing the content to the message delivery system in response to a request from one of a user interface and subscription information contained in the content subscription lists” is anticipated by the sending of a message to a subscriber in response to a retrieval request submitted by the subscriber as spoken of on column 7, lines 41-45 and lines 62-64.

Regarding claim **21**, “receiving data with the message in a first delivery format including the identification information used to identify a given the wireless device” is anticipated by subscriber mailbox 330 of Figure 3 that receives a message from a caller in the caller format (first delivery format) as spoken of on column 7, lines 5-16.

“Changing the first delivery format of the received data to a second delivery format” is anticipated by message translator 340 of Figure 3 that determines the subscriber’s normal retrieval format (second delivery format) from the subscriber profile data and then translates (changes) the message from the caller format (first delivery format) to the subscriber’s normal retrieval format (second delivery format) as spoken of on column 7, lines 20-31.

Lastly, “delivering the received data to the selected wireless device in the second delivery format, wherein the second delivery format is independent of the first delivery format” is anticipated by the sending of the message to the subscriber (selected wireless device) based on the detected type of subscriber equipment and any subscriber specified retrieval format in comparison to the subscriber profile data as spoken of on column 7, lines 41-64.

Regarding claim **22**, “wherein the first delivery format is any of fax, email and a voicemail message and the second delivery format is different from the first delivery format and is selected from the group including voicemail, email, pager text, and text for display on a wireless telephone” is anticipated by the different message translations shown in Table 2 on column 6, lines 20-55.

Regarding claim **23**, “wherein a user has a number of the wireless devices, and the message is received by a first wireless telephone in voice delivery format, the first wireless telephone in text format for display on the first wireless telephone, a pager and a Personal Data Assistant (PDA)” is anticipated by a subscriber having equipment permitting the subscriber to retrieve pending messages in more than one format as spoken of on column 7, lines 45-49.

Regarding claim **24**, “receiving and storing a message having a first delivery format and having content in a first format; the delivery format being one from the group including email, voicemail, and fax” is anticipated by subscriber mailbox 330 of Figure 3 that receives a message from a caller in the caller format (first delivery format) as spoken of on column 7, lines 5-16 as well as the voice and text notification shown in Table 1 on column 5, lines 10-30.

“Determining which of a plurality of wireless devices the message is intended for by looking up prestored user information, device information for the user’s wireless devices, and delivery preference hierarchy information for the users” is anticipated by subscriber mailbox 330 of Figure 3 that stores a database of subscriber profile data (prestored user information, device information, delivery preference hierarchy information) including subscriber-defined information regarding the subscriber’s notification preferences as spoken of on column 5, lines 42-54, as well as service provider 320 that detects caller information and notifies the corresponding subscriber of the pending message according to the subscriber profile data stored in the subscriber mailbox 330 as spoken of on column 7, lines 5-16.

“Translating the first format of the content to a second format compatible with the selected wireless device, including performing one or more operations on the content selected from the group of clipping, transcoding, and decoding” is anticipated by message translator 340 of Figure 3 that determines the subscriber’s normal retrieval format (second format) from the subscriber profile data and then translates (transcoding) the message from the caller format (first format) to the subscriber’s normal retrieval format (second format) as spoken of on column 7, lines 20-31.

Lastly, “transmitting the content in the second format to the selected wireless device in accordance with the device information” is anticipated by the sending of the message to the subscriber (selected wireless device) based on the detected type of subscriber equipment and any subscriber specified retrieval format in comparison to the subscriber profile data (device information) as spoken of on column 7, lines 41-64.

Regarding claim 26, “wherein receiving the delivery hierarchy preference information includes receiving a user’s preference relating to an order of the wireless devices the messages are to be sent when the user has a plurality of the wireless devices” is anticipated by subscriber mailbox 330 of Figure 3 that stores a database of subscriber profile data (identifying information, delivery preference hierarchy information) including subscriber-defined information regarding the subscriber’s notification preferences as spoken of on column 5, lines 42-54.

Regarding claim 27, “wherein the user’s wireless devices provide a variety of content formats, and the order of the wireless devices is established by the user selecting an order of content formats” is anticipated by the subscriber specifying a

Art Unit: 2616

retrieval format of a message such as voice or text form (content formats) as spoken of on column 7, lines 45-52.

Regarding claim **28**, "providing access to the network only to wireless devices defined in the directory database" is anticipated by subscriber mailbox 330 of Figure 3 that uses the stored subscriber profile data (defined devices) to provide stored messages (access) to requesting subscribers as spoken of on column 7, lines 41-64.

Regarding claim **29**, "changing the first delivery format to a second delivery format for transmission to the wireless devices, and wherein the second delivery format is independent of the first delivery format" is anticipated by message translator 340 of Figure 3 that determines the subscriber's normal retrieval format (second delivery format) from the subscriber profile data and then translates (changes) the message from the caller format (first delivery format) to the subscriber's normal retrieval format (second delivery format) as spoken of on column 7, lines 20-31, as well as the sending of the message to the subscriber (selected wireless device) based on the detected type of subscriber equipment and any subscriber specified retrieval format in comparison to the subscriber profile data as spoken of on column 7, lines 41-64.

Regarding claim **30**, "wherein the second delivery format includes one from the group including voicemail, email, pager text, and text for display on a wireless telephone" is anticipated by the different message translations shown in Table 2 on column 6, lines 20-55.

Regarding claim **31**, "receiving wireless device information and delivery preference hierarchy information specifying at least one content format used to deliver

Art Unit: 2616

content to the wireless device” and “storing the wireless device information and the delivery preference hierarchy information” is anticipated by subscriber mailbox 330 of Figure 3 that stores a database of subscriber profile data (device information, delivery preference hierarchy information) including subscriber-defined information regarding the subscriber’s notification preferences (content format) as spoken of on column 5, lines 42-54.

“Receiving content from a message originator” is anticipated by subscriber mailbox 330 of Figure 3 that receives a message from a caller (message originator) in the caller format as spoken of on column 7, lines 5-16.

“Identifying the wireless device(s) to which the received content is directed” is anticipated by service provider 320 that detects caller information and notifies the corresponding subscriber (identifying of device) of the pending message according to the subscriber profile data stored in the subscriber mailbox 330 as spoken of on column 7, lines 5-16.

Lastly, “delivering the received content to the wireless devices in accordance with the delivery preference hierarchy information” is anticipated by the sending of the message to the subscriber (wireless device) based on the detected type of subscriber equipment and any subscriber specified retrieval format in comparison to the subscriber profile data (delivery preference hierarchy information) as spoken of on column 7, lines 41-64.

Regarding claim 32, “translating a first format of the content to a second format compatible with a selected wireless device including performing one or more operations

Art Unit: 2616

on the content selected from the group of clipping, transcoding, and decoding" is anticipated by message translator 340 of Figure 3 that determines the subscriber's normal retrieval format (second format) from the subscriber profile data and then translates (transcoding) the message from the caller format (first format) to the subscriber's normal retrieval format (second format) as spoken of on column 7, lines 20-31.

Lastly, "transmitting the content in the second content format to the wireless device in accordance with the wireless device information" is anticipated by the sending of the message to the subscriber (wireless device) based on the detected type of subscriber equipment and any subscriber specified retrieval format in comparison to the subscriber profile data (device information) as spoken of on column 7, lines 41-64.

Regarding claim 34, "wherein receiving the delivery hierarchy preference information includes receiving a user's preference relating to an order of the wireless devices the messages are to be sent when the user has a plurality of the wireless devices" is anticipated by subscriber mailbox 330 of Figure 3 that stores a database of subscriber profile data (identifying information, delivery preference hierarchy information) including subscriber-defined information regarding the subscriber's notification preferences as spoken of on column 5, lines 42-54.

Regarding claim 35, "wherein the user's wireless devices provide a variety of content formats, and the order of the wireless devices is established by the user selecting an order of content formats" is anticipated by the subscriber specifying a

Art Unit: 2616

retrieval format of a message such as voice or text form (content formats) as spoken of on column 7, lines 45-52.

Allowable Subject Matter

7. Claims **14, 25, and 33** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims **14, 25, and 33**, *Fortman* teaches the methods of claims **13, 24, and 31**, respectively. *Fortman* as well as the other prior art of record do not teach where receiving the delivery hierarchy preference information includes receiving a user's preference relating to an order of content format types that is to be used to send messages to at least one selected wireless device capable of receiving messages in a variety of content formats.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Fortman* (U.S. 6,203,192), *Levac et al.* (U.S. 5,872,926), *Pepe et al.* (U.S. 5,742,905), and *Miller et al.* (U.S. 6,421,707) are other references considered pertinent to this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Moore, Jr. whose telephone number is (571)

Art Unit: 2616

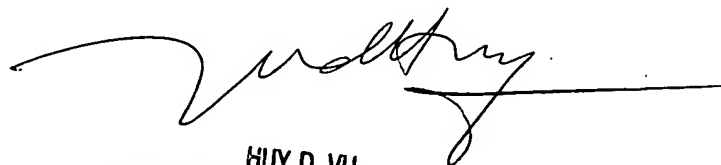
272-3168. The examiner can normally be reached on Monday-Friday (7:30am - 4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached at (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael J. Moore, Jr.
Examiner
Art Unit 2616

mjm MM



HUY D. VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600